



Docket No. NE297-PCT(US)
TAK.049

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Takanori SHIMIZU, et al.

Serial No.: 10/511,630

Group Art Unit: 2883

Filed: October 19, 2004

Examiner: Chiem, Dinh D.

For: OPTOELECTRONIC HYBRID INTEGRATED MODULE AND LIGHT
INPUT/OUTPUT APPARATUS HAVING THE SAME AS COMPONENT

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

RESPONSE TO OFFICE COMMUNICATION

In response to Applicants' Amendment filed on November 30, 2005, the Examiner issued an Office communication, dated February 28, 2006, alleging that the Amendment was not fully responsive to the Office Action dated August 31, 2005.

The Examiner alleges "that there are no claims drawn to the originally elected invention" (see Office communication dated February 28, 2006). Specifically, the Examiner alleges that "the current amended independent claims 1 and 12 are reciting a flip-chip mounting directly to the transparent base material surface, which is limited to the structure of Figures 1-6, non-elected by action on the merits" (see Office communication dated February 28, 2006). Applicants respectfully disagree.

That is, Applicants point out that the Examiner has not issued a Restriction Requirement in the Application. Furthermore, Applicants have not elected any of Figures 1-8 in the Application, because Applicants have not been presented with an Election of Species of Requirement.

The Examiner relies upon M.P.E.P. §§ 818.01 and 818.02(a) to support his erroneous allegations. However, the Examiner has failed to consider M.P.E.P. §818, which defines an

election as “the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application”. No such designation has been made because, as indicated above, the Examiner has not issued a Restriction Requirement.

Furthermore, Applicants submit that originally filed claims 1 and 3-12 were generic to the invention depicted in all of Figures 1-8. Therefore, no implied election of certain figures was made by Applicants, as alleged by the Examiner.

Thus, Applicants Amendment filed on November 30, 2005 is fully responsive to the Office Action dated August 31, 2005. Therefore, the Examiner’s allegations contained in the Office communication dated February 28, 2006 are clearly erroneous and without merit.

Therefore, Applicants respectfully request the Examiner to withdraw the Office communication dated February 28, 2006 and to enter and consider the Amendment filed on November 30, 2005.

If the Examiner wishes to maintain this unreasonable objection, Applicants request the Examiner to identify which features recited in the originally filed claims constituted an election of Figures 7 and 8 of the Application.

Applicants concurrently file herewith a Petition to Enter the Amendment filed on November 30, 2005.

In view of the foregoing, Applicants submit that claims 1 and 3-23, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: March 16, 2006



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